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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

Application Number: 10/741,799

Filing Date: 12/19/2003

Applicant(s): Thomas E. Creamer, et al.

Entitled: SERVICE DELIVERY INSTRUCTION PROCESSING SERVICE

Examiner: Rasha S. Al-Aubaidi

Group Art Unit: 2614

Attorney Docket No.: BOC9-2003-0113US1 (1082-017U)

TRANSMITTAL OF APPEAL BRIEF

Mail Stop Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Submitted herewith is Appellant's Appeal Brief in support of the Notice of Appeal filed July 16, 2008. As this Appeal Brief has been timely filed within the shortened statutory period of two months from the date of the Notice of Appeal, no extension of time under 37 C.F.R. § 1.136 is required. Notwithstanding, please charge any shortage in fees due under 37 C.F.R. §§ 1.17, 41.20, and in connection with the filing of this paper, including extension of time fees, to Deposit Account 50-3829, and please credit any excess fees to such deposit account.

Date: September 15, 2008

Respectfully submitted,

/Steven M. Greenberg/

Steven M. Greenberg, Registration No. 44,725
Customer Number 46322

PATENT

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APPEAL BRIEF

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Sir:

This Appeal Brief is submitted in support of the Notice of Appeal filed July 16, 2008, wherein Appellants appeal from the Examiner's rejection of claims 1 through 13.

I. REAL PARTY IN INTEREST

This application is assigned to International Business Machines Corporation by assignment recorded on December 19, 2003, at Reel 014838, Frame 0558.

II. RELATED APPEALS AND INTERFERENCES

Appellant is unaware of any related appeals and interferences.

III. STATUS OF CLAIMS

Claims 1 through 13 are pending in this Application and have been twice rejected. It is from the multiple rejections of claims 1 through 13 that this Appeal is taken.

IV. STATUS OF AMENDMENTS

Claims 1, 7 and 8 were amended in an amendment dated January 10, 2008 (the "Amendment").

V. SUMMARY OF CLAIMED SUBJECT MATTER

By reference to paragraphs [0021] through [0023] of Appellants' published specification, Appellant has invented a method, system and apparatus for managing delivery instructions through a PSTN. In accordance with Appellants' invention, a customer can contact the delivery service over a PSTN to manage the delivery of the goods or services. When attempting to place the call, the call can be intercepted within the PSTN and identifying information for the calling customer can be extracted from a database within the PSTN. The identifying information can be provided over a data communications network to the delivery service. Using the identifying information received over the data communications network, the delivery service can retrieve information regarding the delivery of goods or services and also, the delivery service can instantly authenticate the calling customer based upon the identifying information.

As the call from the customer is completed over the PSTN, the identifying information, and in particular, the-retrieved information, can be correlated to the completed call such that an operator or an automated call center in the delivery service can access the information through

the data communications network while processing the completed call from the customer. Significantly, as the identifying information can be resolved externally to the service provider from a trusted source within the PSTN, the delivery service can manage the delivery of the goods or services without first prompting the customer for identifying information.

With specific reference to claim 1, a method for managing delivery service instructions can be provided. (Par. [0033]) The method can include prompting a customer through an established telephone call to manage delivery instructions corresponding to a previously ordered good or service (Par. [0035]) without first prompting the customer for identifying information. (Par. [0034]) The method further can include managing the delivery instructions without accessing customer information derived through the phone call. (Par. [0035])

With specific reference to claim 7, a system for managing subscriber services can be provided. (Par. [0024]) The system can include a delivery service instructions management system configured to manage delivery service instructions based upon identifying information associated with customers associated with the delivery service instructions. (Par. [0023]) The system also can include customers calling a delivery service instructions management system over a public switched telephone network (PSTN) to manage respective delivery instructions corresponding to previously ordered goods or services. (Par. [0026]) Finally, the system can include logic disposed within the PSTN, coupled to the delivery service instructions management system over a data communications network, (Par. [0025]) and configured to obtain the identifying information in the PSTN (Par. [0025]) and to provide the obtained identifying

information to the delivery service instructions management system through the data communications network. (Par. [0025])

With specific reference to claim 8, a machine readable storage is recited to embody a computer program for managing delivery service instructions. (Par. [0033]) The computer program includes a routine set of instructions which when executed by a machine causes the machine to perform operations including prompting a customer through an established telephone call to manage delivery instructions corresponding to a previously ordered good or service (Par. [0035]) without first prompting the customer for identifying information. (Par. [0034]) The operations further can include managing the delivery instructions without accessing customer information derived through the phone call. (Par. [0035])

VI. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

Claims 1 through 13 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,651,058 to Hackett-Jones et al. (Hackett-Jones) in view of U.S. Patent Application Publication No. 2002/0065670 by Cho et al. (Cho).

VII. THE ARGUMENT

THE REJECTION OF CLAIMS 1 THROUGH 13 UNDER 35 U.S.C. § 103

For convenience of the Honorable Board in addressing the rejections, claims 2 through 6 stand or fall together with claim 1, and claims 9 through 13 stand or fall together with claim 8.

In rejecting claims under 35 U.S.C. § 103, it is incumbent upon the Examiner to establish a factual basis to support the legal conclusion of obviousness.¹ In so doing the Examiner must make the factual determinations set forth in Graham v. John Deere Co.² Thereafter, the Examiner bears the initial burden, on review of the prior art or on any other ground, of presenting a *prima facie* case of unpatentability.³ Furthermore, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness; however, the analysis need not seek out precise teachings directed to the specific subject matter of the challenged claim, for a court can take account of the inferences and creative steps that a person of ordinary skill in the art would employ.⁴

“Both anticipation under § 102 and obviousness under § 103 are two-step inquiries. The first step in both analyses is a proper construction of the claims. … The second step in the analyses requires a comparison of the properly construed claim to the prior art.”⁵ During patent examination, the pending claims must be “given their broadest reasonable interpretation consistent with the specification,”⁶ and the broadest reasonable interpretation of the claims must also be consistent with the interpretation that those skilled in the art would reach.⁷ Therefore, the Examiner must (i) identify the individual elements of the claims and **properly construe these**

¹ See In re Fine, 837 F.2d 1071, 1073 (Fed. Cir. 1988).

² 383 U.S. 1, 17 (1966).

³ In re Oetiker, 977 F.2d 1443, 1445 (Fed. Cir. 1992).

⁴ KSR Int'l Co. v. Teleflex Inc., 127 S. Ct. 1727, 1741 (2007)(quoting In re Kahn, 441 F.3d 977, 988 (Fed. Cir. 2006)).

⁵ Medicchem, S.A. v. Rolabo, S.L., 353 F.3d 928, 933 (Fed. Cir. 2003) (internal citations omitted).

⁶ In re ICON Health and Fitness, Inc., 496 F.3d 1374, 1379 (Fed. Cir. 2007) (“[T]he PTO must give claims their broadest reasonable construction consistent with the specification. Therefore, we look to the specification to see if it provides a definition for claim terms, but otherwise apply a broad interpretation.”); In re Hyatt, 211 F.3d 1367, 1372, 54 USPQ2d 1664, 1667 (Fed. Cir. 2000).

⁷ In re Cortright, 165 F.3d 1353, 1359, 49 USPQ2d 1464, 1468 (Fed. Cir. 1999)

individual elements,⁸ , and (ii) identify corresponding elements disclosed in the allegedly anticipating reference and compare these allegedly corresponding elements to the individual elements of the claims.⁹ This burden has not been met.

Claim 1 recites a method for managing delivery service instructions. For the convenience of the Honorable Board, the entirety of claim 1 is reproduced as amended:

1. A method for managing delivery service instructions, the method comprising:

prompting a customer through an established telephone call to manage delivery instructions corresponding to a previously ordered good or service without first prompting said customer for identifying information; and,

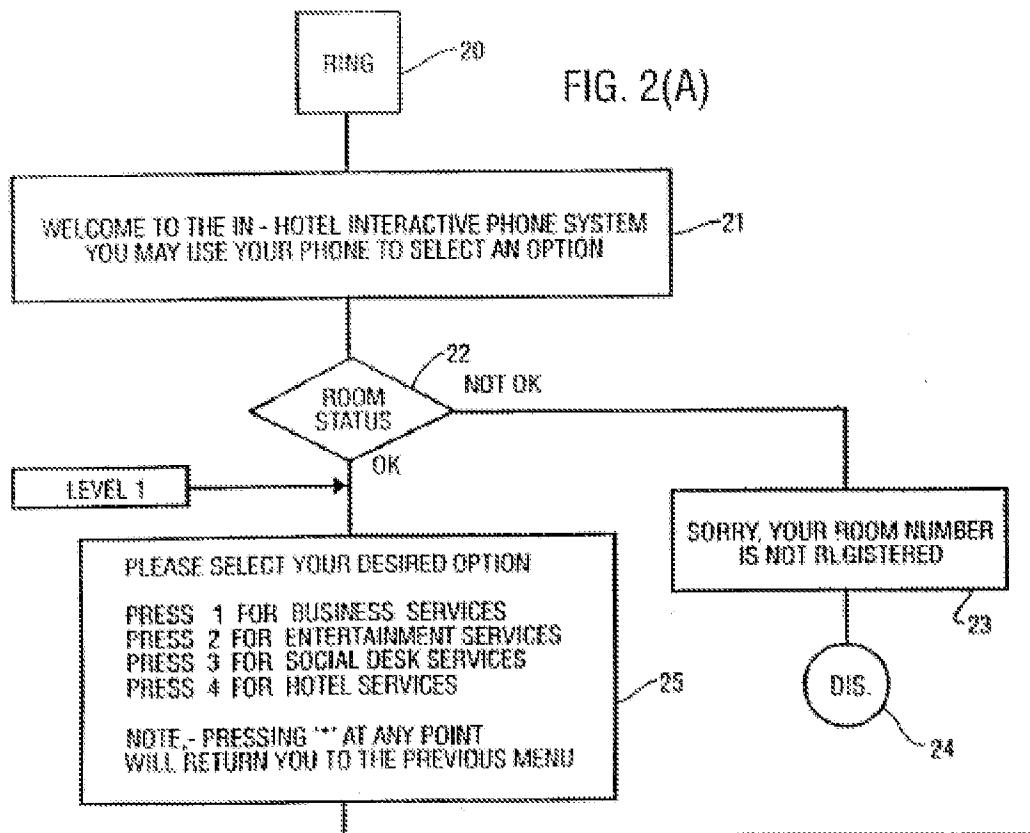
managing said delivery instructions without accessing customer information derived through said phone call.

Integral to claim 1 (and also claims 7 and 8) is the management of delivery instructions prompted over an established telephone call without accessing customer information derived through the telephone call. On page 3 of the Final Office Action dated April 17, 2008 (the "Final Office Action"), Examiner refers only to Hackett-Jones, Figure 2A, boxes 21, 22 and 25 and also column 2, lines 25 through 39 for the entirety of the foregoing integral teaching.

At the outset, Appellants note that Examiner has provided an implicit claim construction for the disputed limitation of "delivery instruction". Specifically, on page 3 of the Final Office Action, Examiner compares "delivery instruction" to box 25 of Figure 2A of Hackett-Jones. For the convenience of the Honorable Board, the relevant portion of Figure 2A is provided herein as follows:

⁸ See also, Panduit Corp. v. Dennison Mfg. Co., 810 F.2d 1561, 1567-68 (Fed. Cir. 1987) (In making a patentability determination, analysis must begin with the question, "what is the invention claimed?" since "[c]laim interpretation, . . . will normally control the remainder of the decisional process"); see Gechter v. Davidson, 116 F.3d 1454, 1460 (Fed. Cir. 1997) (requiring explicit claim construction as to any terms in dispute).

⁹ Lindermann Maschinenfabrik GMBH v. American Hoist & Derrick Co., 730 F.2d 1452, 221 USPQ 481 (Fed. Cir. 1984).



Thus, Examiner equates "Business Services", "Entertainment Services", "Social Desk Services" and "Hotel Services" as Appellants' claimed "delivery instructions".

Examiner has erred in applying a claim construction of "delivery instructions" as the various and sundry services enumerated in box 25 of Figure 2A. Examiner in failing to provide a relevant claim construction for "delivery instructions" has committed clear error as well-understood under the law.¹⁰

¹⁰ See Gechter v. Davidson, 116 F.3d 1454, 1460 (Fed. Cir. 1997) (requiring explicit claim construction as to any terms in dispute).

In this regard, "delivery instructions" as it is commonly understood means "instructions for the delivery of goods or services". In particular, the term "instructions" as set forth in Merriam-Webster's dictionary means, "orders or directions". Appellant's use of the term "delivery instructions" in paragraph [0021] of Appellants' specification is consistent with the ordinary meaning of "delivery instructions". In this regard, Appellant's state at paragraph [0021],

As used herein, delivery instructions can include the specification or modification of a time or place for the delivery of goods or services. Additionally, the term delivery instructions can include the specification of a delivery process such as requiring zero or more signatures by particular individuals, directions to the address, and one or more actions to be performed prior to, during and subsequent to the physical delivery of the goods or services. The management of the delivery instructions can be performed by the vendor of the goods or services, or a delivery agent acting on behalf of the vendor.

The accepted law of claim construction set forth by the Federal Circuit and followed by the United States Patent and Trademark Office does not permit the Examiner to construe an essential claim term *as having a meaning contrary to the ordinary meaning of a term when used consistently within Appellants' specification*. Rather, during patent examination, the pending claims must be "given their broadest reasonable interpretation consistent with the specification."¹¹ The Federal Circuit's en banc decision in Phillips v. AWH Corp.¹² expressly recognized that the United States Patent and Trademark Office employs the "broadest reasonable interpretation" standard. Examiner's failure to properly construe "delivery instructions" as set forth in claims 1, 7 and 8 stretches the standard set forth in Phillips and is clear reversible error.

¹¹ M.P.E.P. 2111.

¹² 415 F.3d 1303, 75 USPQ2d 1321 (Fed. Cir. 2005)(The Patent and Trademark Office ("PTO") determines the scope of claims in patent applications not solely on the basis of the claim language, but upon giving claims their broadest reasonable construction "in light of the specification as it would be interpreted by one of ordinary skill in the art." In re Am. Acad. of Sci. Tech. Ctr., 367 F.3d 1359, 1364[, 70 USPQ2d 1827] (Fed. Cir. 2004). Indeed, the rules of the PTO require that application claims must "conform to the invention as set forth in the remainder of the specification and the terms and phrases used in the claims must find clear support or antecedent basis in the description so that the meaning of the terms in the claims may be ascertainable by reference to the description." 37 CFR 1.75(d)(1).)

Of course, it goes without saying that Examiner's failure to properly construe "delivery instructions" does not permit a proper comparison of the cited art to Appellants' claimed subject matter to provide for the identical disclosure of Appellants' claimed subject matter in the cited art as required to establish a prima facie case of obviousness under 35 U.S.C. § 103. In this regard, column 2, lines 25 through 39 of Hackett-Jones provide:

In accordance with the invention the automatic exchange system is also able to perform a management function in **establishing the identity of a calling party** in terms of the relevant hotel room number, establishing the status of the corresponding hotel room, for example whether the hotel room is vacant or is validly let to a hotel guest, and providing a corresponding message to a calling party. Thus, for example, if a call is received from a hotel room identified as vacant and not having valid status for the establishment of a call to the interactive service, a message can be returned indicating that the requested call cannot be connected. If the status of the calling room is valid, then a message can be returned offering a variety of services to the caller, and requesting transmission of a signal selecting a corresponding service.

Importantly, the cited portion of Hackett-Jones fails to disclose the management of delivery instructions received over an established telephone call without accessing customer information derived through the telephone call. Rather, the cited portion of Hackett-Jones only provides a teaching directed towards identifying a calling party (through a telephone call).

Further, the entirety of Hackett-Jones (not merely the cited portions of Hackett-Jones) wholly lack a teaching directed to the identification of a calling party with means outside of an established telephone call with the calling party. Rather, column 3, line 60 through 64 of Hackett-Jones teach precisely the opposite--the identification of the calling party from over the established telephone call with the calling party. In particular, column 3, lines 60 through 64 provide in relevant part:

The control programme of the interactive system 9 will then cause the appropriate interface card to answer the call and transmit an answering message to the caller as indicated at point 21. **At the same time, the calling telephone station 3 will be interrogated by the hotel interactive system to obtain a multifrequency tone signal identifying the room number in which the telephone station is located.**

Thus, the disclosure of Hackett-Jones "teaches away" from Appellants' invention. Of importance, the Hackett-Jones reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention.¹³

Based upon the foregoing, Appellant respectfully submits that Examiner neither has properly construed the individual element "delivery instructions" of Appellants' claims, nor has Examiner identified the requisite corresponding elements of Hackett-Jones and Cho relating to such limitations disclosed in the prior art references and compared these allegedly corresponding elements to the individual elements of Appellants' claims. As a result, Appellants believe that the Examiner's rejections under 35 U.S.C. § 103(a) are not viable. Appellant, therefore, respectfully solicits the Honorable Board to reverse the Examiner's rejections under 35 U.S.C. § 103(a).

Date: September 16, 2008

Respectfully submitted,

/Steven M. Greenberg/
Steven M. Greenberg
Registration No. 44,725
Customer Number 46321

¹³ W.L. Gore & Associates, Inc. v. Garlock, Inc., 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984)

VIII. CLAIMS APPENDIX

1. (Previously Amended) A method for managing delivery service instructions, the method comprising:

prompting a customer through an established telephone call to manage delivery instructions corresponding to a previously ordered good or service without first prompting said customer for identifying information; and,

managing said delivery instructions without accessing customer information derived through said phone call.

2. (Original) The method of claim 1, wherein said prompting step comprises the step of prompting a customer through an established telephone call to change said delivery instructions without first prompting said customer for identifying information.

3. (Original) The method of claim 2, wherein said managing step comprises the step of changing said delivery instructions without accessing customer information derived through said phone call.

4. (Original) The method of claim 3, wherein said changing step comprises the step of changing at least one of an established delivery address, directions to said established delivery address, a contact phone number, and a procedure to be performed either before, during or after performing a delivery according to said delivery instructions.

5. (Original) The method of claim 1, further comprising the step of transferring said phone call to a customer service representative responsive to a request for live help by said customer.

6. (Original) The method of claim 1, further comprising the step of charging said customer for managing said delivery instructions.

7. (Previously Amended) A system for managing subscriber services, the system comprising:

a delivery service instructions management system configured to manage delivery service instructions based upon identifying information associated with customers associated with said delivery service instructions;

a plurality of customers calling a delivery service instructions management system over a public switched telephone network (PSTN) to manage respective delivery instructions corresponding to previously ordered goods or services; and,

logic disposed within said PSTN, coupled to said delivery service instructions management system over a data communications network, and configured to obtain said identifying information in said PSTN and to provide said obtained identifying information to said delivery service instructions management system through said data communications network.

8. (Previously Amended) A machine readable storage having stored thereon a computer program for managing subscriber services, the computer program comprising a routine set of instructions which when executed by a machine cause the machine to perform the steps of:

prompting a customer through an established telephone call to manage delivery instructions corresponding to a previously ordered good or service without first prompting said customer for identifying information; and,

managing said delivery instructions without accessing customer information derived through said phone call.

9. (Original) The machine readable storage of claim 8, wherein said prompting step comprises the step of prompting a customer through an established telephone call to change said delivery instructions without first prompting said customer for identifying information;

10. (Original) The machine readable storage of claim 9, wherein said managing step comprises the step of changing said delivery instructions without accessing customer information derived through said phone call.

11. (Original) The machine readable storage of claim 10, wherein said changing step comprises the step of changing at least one of an established delivery address, directions to said established delivery address, a contact phone number, and a procedure to be performed either before, during or after performing a delivery according to said delivery instructions.

12. (Original) The machine readable storage of claim 8, further comprising the step of transferring said phone call to a customer service representative responsive to a request for live help by said customer.

13. (Original) The machine readable storage of claim 8, further comprising the step of charging said customer for managing said delivery instructions.

IX. EVIDENCE APPENDIX

No evidence submitted pursuant to 37 C.F.R. §§ 1.130, 1.131, or 1.132 of this title or of any other evidence entered by the Examiner has been relied upon by Appellant in this Appeal, and thus no evidence is attached hereto.

X. RELATED PROCEEDINGS APPENDIX

Since Appellant is unaware of any related appeals and interferences, no decision rendered by a court or the Board is attached hereto.